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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/629,416 | 07/29/2003 | Steven P. McGahn | 112300-1666 | 5965 |
| 29159 | 7590 | 09/14/2006 | EXAMINER | |
| BELL, BOYD & LLOYD LLC P. O. BOX 1135 CHICAGO, IL 60690-1135 | | | SHAH, MILAP | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3712 | |

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|------------------------------|------------------------|---------------------|--|
| Office Action Summary | Application No. | Applicant(s) | |
| | 10/629,416 | MCGAHN ET AL. | |
| | Examiner | Art Unit | |
| | Milap Shah | 3712 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-74 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-74 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on July 25, 2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-46, 49-51, & 54-74 are rejected under 35 U.S.C. 103(a) as being unpatentable over Adams, U.S. Patent 5,823,874 (Oct. 20, 1998) (hereinafter “*Adams*”) in view of Groetchen, U.S. Patent 1,978,395 (Apr. 23, 1934) (hereinafter “*Groetchen*”) & Official Notice.

Adams discloses a gaming device incorporating primary and secondary game displays within a single housing. See *fig. 1*. The primary embodiment employs a reel-type slot game as a primary display and a wheel-type game as a secondary display. See *fig. 1; col. 6:16-33*. However, *Adams* suggests the displays may be replaced with other standard gaming units that preferably include mechanical displays to reveal outcomes because they provide patrons a heightened level of anticipation and excitement. See *col. 3:53-60*,

col. 6:16-33. Furthermore, *Adams* suggests the games should provide players with clear visual and audible indications to be readily discernable. *See id.* Still furthermore, the reference suggests that the bonus may alternatively employ games requiring elements of player skill. *See col. 6:40-47*.

In specific regards to the Applicants' claims, *Adams* teaches the following features:

- a. Cabinet with primary and secondary display supported by the cabinet. *See fig. 1*. A primary game is adapted to the primary display and a secondary game is adapted to the secondary display.
- b. A display mounted to the cabinet, a plurality of symbols displayed on a portion of the display & a processor operable to select symbols, operate the gaming device's features, and control the display to display the selected symbols. *See col. 5:30-49*. The player activates the selection of a symbol, which is incorporated in the award (i.e. a value enticement award).
- c. A directional indicator displayed by the first display which directs the player to the second display and processor which causes the directional indicator to direct the player to the second display. *See col. 2:30-48, 4:46-59. (Claims 17-19, 44, 45, 61, & 65)*

However, *Adams* lacks slidable members (i.e. a first and/or second movable member, wherein each movable member has its own actuator) selectively masking a portion of the secondary display wherein selected symbols on the secondary display are revealed by actuating the movable member(s) and a processor operable to cause the movable member(s) to reveal a portion of the video display. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

Groetden discloses a slot machine device in which slidable member (i.e. shutters) selectively mask a display wherein the device selects symbol from a plurality of symbols; displays symbols on the display; and reveals the symbols by moving the movable member. *See fig. 1-3; pp. 1:39-54; 1:63-6, 3:13-58*. The reference suggests masking the outcomes with movable shutters allows various games with the device. *See*

p. 3:44-50. Generally, *Groetchen* describes a mechanical game device allowing the successive display of game outcomes using movable members.

In view of *Groetchen*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify *Adams*, wherein a secondary display provides bonus payout, to add a secondary display wherein movable members selectively masks the secondary display, the device selects a symbol from a plurality of symbols; displays the symbol on the secondary display; and actuates the movable member to move to reveal the symbol by actuating the movable member. As suggested by *Adams*, the modification would provide a standard gaming including moving objects that reveal outcomes with clear visual and audible indications and thereby enhance the device by heightening players' level of anticipation and excitement. See col. 3:53-60. Furthermore, as suggested by *Groetchen*, the modification would provide an enhanced secondary game display supporting a variety of games. See p. 3:44-50.

The combination of *Adams* and *Groetchen* appears to lack that the processor is in communication with a server through a data network and that the server is capable of providing the gaming device instructions to operate at least the movable members. However, the Examiner is taking Official Notice, that regardless of these deficiencies, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the gaming device specified by the combination of *Adams* and *Groetchen* on a gaming network, such that the processor is in communication with a host server and the host server provides instructions to the gaming device. One would be so motivated to add a gaming device to a network and a host server for many reasons including distributed gaming, centralized gaming information, and to easily supply media content to gaming devices such that, the gaming device can essentially be a dummy computer that accepts any programmed game, thus, reducing costs for replacing entire memory chips or devices with new games. Additional motivation lies in the popular progressive gaming area, such that a host server must keep track of all money added to the progressive jackpot by the gaming devices

Art Unit: 3712

that are a part of the jackpot, thus, connectivity to a server through a data network must be present, such that when a particular gaming device wins the progressive jackpot or the like, the host server can transmit the instructions to the gaming device to reveal a secondary display with the bonus information. For at least these reasons, the Examiner submits that it would have been notoriously well known in the art to provide the gaming device described above on a data network and in communication with a host server, in which that host server is capable of providing instructions to said gaming device in order for distributed gaming, centralized information, and/or media distribution to be possible. Therefore, obviously the processor-to-server connection is capable of providing instructions from the server to the gaming device in situations such as the progressive jackpot described above.

In further regards to claims 2, 19 and 32: *Adams* additionally teaches a processor for electromechanically controlling a secondary display comprised of a mechanical indicator in which the processor controls the operation of the secondary display. *See* 3:60-4:6. Thus, it would have been obvious to an artisan at the time of the invention to modify the gaming device described by the combination of *Adams* and *Groetchen*, to add the feature of a processor operable to cause the movable member to reveal a portion of the video display to control the movable members. As taught by *Adams*, the modification would enhance the device by allowing it to be controlled by a random number generator while maintaining the mechanical appearance of the game. *See* *col.* 3:61-4:6.

In regards to claims 3, 22, 29, 34 & 50: *Groetchen* teaches a triggering event wherein a processor causes the actuator to move the movable member to reveal the secondary display upon occurrence of the triggering event. *See* *p.* 3:41-50. See discussion above with respect to the designated instruction from the server. The server is capable of sending any instruction that a processor can perform, to the gaming device.

In regards to claims 4-6, 44 and 51: *Groetchen* additionally teaches a plurality of slidable members that mask first and second portions of the second display wherein a motor are connected to each member and a processor causes the motors to slide the members to reveal masked symbols such as award indicia. *See fig. 1-5; p. 3:41-50*. See also discussion above with respect to the designated instruction from the server. The server is capable of sending any instruction that a processor can perform, to the gaming device.

In regards to claims 7, 20, 46, 59, 65 and 66: *Adams* teaches symbols that include award indicia. *See fig. 1*.

In regards to claims 8, 24, 43, 54, 60, and 67: The game system described by the combination of *Adams* and *Groetchen* does not disclose a speaker by which the processor generates a sound effect when the movable members reveal a secondary display. Regardless, it is notoriously well known in the art for gaming devices to incorporate processors that generate a sound effects through speakers in association with game events to provide players with audio indications in association with visual displays to enhance the interaction and entertainment of players. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to add the feature of a speaker by which the processor generates a sound effect when the movable member reveals a secondary display to the gaming device described by the combination of *Adams* and *Groetchen* to enhance the device by improving communicating and entertainment through increased interaction with players.

In regards to claims 9, 23 and 35: *Groetchen* teaches an actuator causing the movable member to reveal the secondary display after a player activated device is activated. *See id.* See also discussion above with respect to the designated instruction from the server. The server is capable of sending any instruction that a processor can perform, to the gaming device.

In regards to claims 10, 25 and 36: *Adams* teaches a secondary display that is a video display. *See col. 5:30-50*. The reference does not describe television, dot-matrix, cathode-ray tubes, light-emitting diode,

Art Unit: 3712

liquid crystal, and electro-luminescent displays. Regardless, these display means are equivalents substitutable for the same purpose of displaying visual game information to a player. Thus, it would have been obvious to an artisan at the time of the invention to modify *Adams*, wherein the secondary display is a video display, to substitute television, dot-matrix, cathode-ray tubes, light-emitting diode, liquid crystal, and electro-luminescent displays to display visual game information to a player.

In regards to claims 11-16, 26, 37-42, 55, 56, 62-64 and 68-71: *Adams* teaches a secondary display that includes a mechanical reel, movable roller or wheel displaying award indicia. *See* *col. 6:17-33*.

In regards to claims 21, 33 and 49 *Groetchen* teaches movable members made of non-transparent material. *See fig. 1-5; p. 3:41-50*.

Claims 47 & 48 are rejected under 35 U.S.C. 103(a) as being unpatentable *Adams* in view of *Groetchen* & Official Notice, as applied to claims 1-46, 49-51, & 54-74 above, in further view of Takeuchi et al., U.S. Patent 6,089,066 (Jul. 11, 2000) (hereinafter “*Takeuchi*”).

The gaming system suggested by the combination of *Adams* in view of *Groetchen* & Official Notice describes all the features of the instant claims except sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is revealed. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

Takeuchi discloses a game system analogous to *Groetchen* in which movable members are driven by a motor to mask a portion of a game display. *See fig. 1-3*. In particular, the reference describes sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is set in its desired position. *See col. 5:36-58*.

In view of *Takeuchi*, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify The gaming system suggested by the combination of *Adams* in view of *Groetchen & Official Notice*, wherein a movable members are driven by a motor to mask a portion of a game display, to add the feature of sensing devices to stop the motors from sliding the movable members and optical switches located to detect when a display is revealed to provide feedback to the game processor and thereby improve control or detect malfunctions in the operation of the movable member.

Claims 52 & 53 are rejected under 35 U.S.C. 103(a) as being unpatentable *Adams* in view of *Groetchen & Official Notice*, as applied to claims 1-46, 49-51, & 54-74 above, further in view of *Heywood et al.*, U.S. Patent 4,326,351 (Apr. 27, 1982) (hereinafter "*Heywood*").

As stated previously, *Adams* teaches connecting a mechanical secondary display to a processor such that a processor selects symbols for displayed on the secondary display medium. *See col. 3:61-67*. Furthermore, the reference suggests that other known mechanical displays may be substituted for the described wheel display. *See 6:26-34*. Thus, the gaming system suggested by the combination of *Adams* with *Groetchen & Official Notice* describes all the features of the instant claim except a secondary display device having a medium exhibiting symbols that is coupled between a drive roller and follower roller such that one of the symbols is shown in the second display. Regardless of the deficiencies, these features were known in the art at the time of the invention and would have been obvious to an artisan.

Heywood discloses a having a medium exhibiting symbols that is coupled between a drive roller and follower roller such that one of the symbols is shown in the second display wherein a processor controls the medium to display a selected symbol. *See fig. 2; 1:66-2:20*. The reference teaches that the roller driven medium provides a better alternative to reels than video displays because players can see the symbols belong to an unalterable strip and avoid an artificial appearance. *See col. 1:38-56*.

Consequently, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the gaming system described by the combination of *Adams* with *Groetchen* & Official Notice to add the feature of a secondary display device having a medium exhibiting symbols that is coupled between a drive roller and follower roller such that one of the symbols is shown in the second display to provides a alternative to a reel display while allowing players can see the symbols belong to an unalterable strip and avoiding an artificial appearance.

In regards to claim 53: The combination of *Adams* with *Groetchen* & Official Notice teaches an actuator causing the movable member to reveal the secondary display after a player activated device is activated. *See id.*

Response to Arguments

Applicant's arguments filed July 25, 2006, with respect to claims 1-74, have been fully considered but are not persuasive. In particular, the applicant argues that the claimed invention distinguishes over the combination of *Adams* and *Groetchen* because there is not motivation to combine *Adams* with *Groetchen*. The examiner respectfully disagrees and submits the following. It is to be noted that a majority of this response was already submitted with the previous office action. The same argument with respect to obviousness has been resubmitted, thus, the Examiner resubmits generally the same response.

In response to applicant's argument that there is no suggestion to combine the references, the Examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *See In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347,

21 USPQ2d 1941 (Fed. Cir. 1992). The standard of patentability is what the prior art taken as a whole at a time prior to the invention suggests to an artisan.

In this case, *Adams* discloses a gaming device incorporating primary and secondary game displays within a single housing. *See fig. 1*. The primary embodiment employs a reel-type slot game as a primary display and a wheel-type game as a secondary display. *See fig. 1; col. 6:16-33*. However, *Adams* suggests the displays may be replaced with other standard gaming units that preferably include mechanical displays to reveal outcomes because they provide patrons a heightened level of anticipation and excitement. *See col. 3:53-60, col. 6:16-33*. Furthermore, it suggests the games should provide players with clear visual and audible indications to be readily discernable. *See id.* Still furthermore, *Adams* suggests that the bonus game may alternatively employ games requiring elements of player skill. *See col. 6:40-47*.

Groetchen discloses a slot machine device in which slidable member (i.e. shutters) selectively mask a display wherein the device selects symbol from a plurality of symbols; displays symbols on the display; and reveals the symbols by moving the moveable member. *See fig. 1-3; pp. 1:39-54; 1:63-6, 3:13-58*. The reference suggests masking the outcomes with movable shutters allows various games with the device, including games involving player skill (e.g. stud poker and blackjack). *See fig. 1; p. 3:44-50*. The fact that the game's intended use is for entertainment purposes only and does not determine if the player will obtain their vended item or not, is not enough to suggest unobviousness. It is merely an intended use for the structure of having a slidable member covering game outcomes. Generally, *Groetchen* describes a mechanical game device allowing the successive display of game outcomes using movable members.

Thus, in this case the combination of *Adams* with *Groetchen*, when taken as a whole, suggests to an artisan at a time prior to the invention a gaming device having a mechanical secondary display wherein moveable members selectively mask the secondary display, the device selects a symbol from a plurality of symbols; displays the symbol on the secondary display; and actuates the moveable member to move to

Art Unit: 3712

reveal the symbol by actuating the moveable member. As suggested by *A dams*, the modification would provide a standard gaming with new games providing winning payouts wherein a discernable secondary display includes moving objects that gradually reveal outcomes with clear visual and/or audible indications and thereby enhance the device by heightening players' level of anticipation and excitement. *See* *col. 1:35-49, 3:53-60*. Furthermore, as suggested by *Groetchen*, the modification would provide an enhanced game display supporting a variety of games. *See p. 3:44-50*.

For at least the reasons stated above, the Examiner respectfully submits that there is sufficient motivation to make the combination *A dams* with *Groetchen*. The current rejections add Official Notice, however, the response above pertains *A dams* and *Groetchen* only, since it appears the obviousness argument was with respect to unamended claim language.

The Applicant further argues that it would not have been obvious, given the combination of *A dams* and *Groetchen* as described, to come up with a secondary display type being one of the following: a video display, television, dot-matrix, cathode-ray tubes, light emitting diode, liquid crystal, or electro-luminiscent displays. However, *A dams* itself teaches that the secondary display, (figure 3[bonus indicator 250]) is an electronic video display (column 5, lines 30-39).

Applicant's arguments with respect to claims 1-74 and the newly added claim language have been fully considered, but they are not persuasive. As the arguments pertain to amended claim language, they are addressed in the updated rejections above.

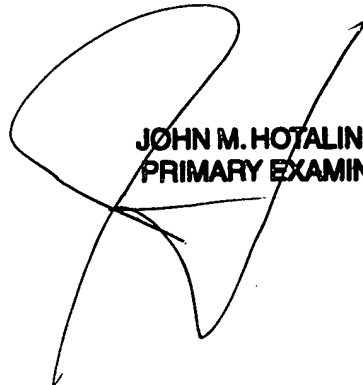
Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571) 272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on (571) 272-4437. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

M.B.S.



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